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33893 7590 01/31/2007 JLB CONSULTING, INC. c/o INTELLEVATE P.O. BOX 52050 MINNEAPOLIS, MN 55402			EXAMINER VETTER, DANIEL	
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SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
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Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/612,283

Applicant(s)

BURTON ET AL.

Examiner

Daniel P. Vetter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 30 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/12/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Claims 1-22 are pending in this application.

Drawings

1. The drawings were received on June 30, 2003. These drawings are accepted by the Examiner.

Specification

2. The abstract of the disclosure is objected to because it is not a single paragraph. Correction is required. See MPEP § 608.01(b).

Claim Objections

3. Claim 22 objected to because of the following informalities: "selected characteristic *or* each of the plurality of items" in line 4 appears to be a typographical error. Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1, 3-5, 10, 12-14, and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg, U.S. Pat. No. 4,656,591 (Reference A of the attached PTO-892) in view of Bruns, U.S. Pat. Pub. No. 2004/0107151 (Reference B of the attached PTO-892).

6. As per claim 1, Goldberg teaches a method operable on a computer for selecting and packaging items for mailing, comprising the steps of: receiving a customer order specifying a plurality of items for shipping by mail (column 4, lines 15-16); retrieving a selected characteristic for each of the plurality of items (column 2, lines 26-27); printing a mailer including a control indicia on the mailer (column 5, line 65), automatically selecting, based on the control indicia, items for inclusion in each order (column 1, line 36 ("automated picking"); column 2, lines 25-29; column 4, lines 21-25), and packaging each of the orders individually so that the customer order comprises multiple packages (column 2, lines 43-44); and mailing the single or multiple packages to the customer (column 3, lines 18-19, 37). Goldberg does not teach determining, based on the selected characteristic, if a single delivery containing the plurality of items will exceed a desired threshold; if the single delivery will not exceed the desired threshold, packaging the plurality of items in a single delivery; if the single delivery will exceed the desired threshold, dividing, based on the selected characteristic, the customer order into multiple sub-orders, and each sub-order including a subset of the plurality of items

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selected so that the sub-order will be at the desired threshold. Bruns teaches determining, based on the selected characteristic, if a single delivery containing the plurality of items will exceed a desired threshold (§ 0008); if the single delivery will not exceed the desired threshold, packaging the plurality of items in a single delivery (§ 0014); if the single delivery will exceed the desired threshold, dividing, based on the selected characteristic, the customer order into multiple sub-orders, and each sub-order including a subset of the plurality of items selected so that the sub-order will be at the desired threshold (§ 0005). It would have been prima facie obvious to one having ordinary skill in the art to incorporate determining, based on the selected characteristic, if a single delivery containing the plurality of items will exceed a desired threshold; if the single delivery will not exceed the desired threshold, packaging the plurality of items in a single delivery; if the single delivery will exceed the desired threshold, dividing, based on the selected characteristic, the customer order into multiple sub-orders, and each sub-order including a subset of the plurality of items selected so that the sub-order will be at the desired threshold into the method taught by Goldberg so that the customer will receive products faster by eliminating delivery constraints (as taught by Bruns, § 0009). Goldberg does not explicitly teach that the orders are sub-orders, however, Bruns teaches that the orders are sub-orders (§§ 0017) and it would have been prima facie obvious to include that the orders are sub-orders because the order has been split (as

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taught by Bruns, ¶ 0009). Bruns does not explicitly teach that the deliveries are packages, however, Goldberg teaches that the deliveries are packages (column 3, line 13; column 4, lines 33-38). Bruns teaches that the threshold is a weight or capacity threshold but does not explicitly teach that the threshold is a postal rate. However, the applied references have been interpreted and applied assuming basic knowledge of one of ordinary skill in the art. According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. As was held in *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that, which is disclosed therein. In this case, it is commonly known in that art that postage rates are based upon weight. Therefore, even though Bruns does not explicitly use postage rates as a threshold, it would have been prima facie obvious to one having ordinary skill in the art to use such rates since they are used for shipping products and are based upon the same thresholds such as weight taught in Bruns.

7. As per claim 3, Goldberg in view of Bruns teaches the method of claim 1 as described above. Bruns further teaches the selected characteristic is chosen from the group comprising: item weight, item thickness and item size (¶ 0006). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the selected characteristic is chosen from the group comprising: item

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weight, item thickness and item size into the method taught by Goldberg in view of Bruns because weight is a delivery parameter used for shipments (as taught by Bruns, ¶ 0007).

8. As per claim 4, Goldberg in view of Bruns teaches the method of claim 1 as described above. Goldberg further teaches printing a mailer for each order (column 2, line 5; column 4, line 43); placing each mailer on an assembly line (column 4, lines 47-49); and placing each item in each order on the associated mailer as the mailer traverses the assembly line (column 4, line 68 - column 5, line 7; column 6, lines 49-51). Goldberg does not explicitly teach that the orders are sub-orders, however, Bruns teaches that the orders are sub-orders (¶¶ 0017) and it would have been prima facie obvious to include that the orders are sub-orders because the order has been split (as taught by Bruns, ¶ 0009).

9. As per claim 5, Goldberg in view of Bruns teaches the method of claim 4 as described above. Goldberg further teaches each mailer comprises a printed paper mailer (column 2, line 68); each paper mailer includes, a bar code indicative of the items to be packaged with the mailer (column 3, line 55) and a customer address (column 3, lines 43-44; column 4, lines 67-68). Goldberg does not explicitly teach that these are on a first and a second side of the mailer. It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate that these are on a

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first and a second side of the mailer because this is a mere choice of arrangement and such differences from the prior art do not hold any patentable weight. *In re Japikse*, 86 USPQ 70 (CCPA 1950). Applicant has not demonstrated the criticalities of this arrangement.

10. As per claim 10, Goldberg teaches a system for selecting and packaging items for mailing, comprising: a processor; a memory connected to the processor, the memory storing data and instructions for controlling the operation of the processor (column 2, lines 24-25; column 6, lines 48, 57; Examiner is interpreting a processor; a memory connected to the processor, the memory storing data and instructions for controlling the operation of the processor as a computer); the processor operative to perform the steps of receiving a customer order specifying a plurality of items for shipping by mail (column 2, lines 24-25; column 4, lines 15-16); retrieving, from the memory, a selected characteristic for each of the plurality of items (column 2, lines 26-28); printing a mailer including a control indicia on the mailer (column 5, line 65), automatically selecting, based on the control indicia, items for inclusion in each order (column 1, line 36 ("automated picking"); column 2, lines 25-29; column 4, lines 21-25), and packaging each of the orders individually so that the customer order comprises multiple packages (column 2, lines 43-44); and mailing the single or multiple packages to the customer (column 3, lines 18-19, 37). Goldberg does not teach determining, based on the

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selected characteristic, if a single delivery containing the plurality of items will exceed a desired threshold; if the single delivery will not exceed the desired threshold, packaging the plurality of items in a single delivery; if the single delivery will exceed the desired threshold, dividing, based on the selected characteristic, the customer order into multiple sub-orders, and each sub-order including a subset of the plurality of items selected so that the sub-order will be at the desired threshold. Bruns teaches determining, based on the selected characteristic, if a single delivery containing the plurality of items will exceed a desired threshold (§ 0008); if the single delivery will not exceed the desired threshold, packaging the plurality of items in a single delivery (§ 0014); if the single delivery will exceed the desired threshold, dividing, based on the selected characteristic, the customer order into multiple sub-orders, and each sub-order including a subset of the plurality of items selected so that the sub-order will be at the desired threshold (§ 0005). It would have been prima facie obvious to one having ordinary skill in the art to incorporate determining, based on the selected characteristic, if a single delivery containing the plurality of items will exceed a desired threshold; if the single delivery will not exceed the desired threshold, packaging the plurality of items in a single delivery; if the single delivery will exceed the desired threshold, dividing, based on the selected characteristic, the customer order into multiple sub-orders, and each sub-order including a subset of the plurality of items selected so that the sub-order will

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be at the desired threshold into the system taught by Goldberg so that the customer will receive products faster by eliminating delivery constraints (as taught by Bruns, ¶ 0009). Goldberg does not explicitly teach that the orders are sub-orders, however, Bruns teaches that the orders are sub-orders (¶¶ 0017) and it would have been prima facie obvious to include that the orders are sub-orders because the order has been split (as taught by Bruns, ¶ 0009). Bruns does not explicitly teach that the deliveries are packages, however, Goldberg teaches that the deliveries are packages (column 3, line 13; column 4, lines 33-38). Bruns teaches that the threshold is a weight or capacity threshold but does not explicitly teach that the threshold is a postal rate. However, the applied references have been interpreted and applied assuming basic knowledge of one of ordinary skill in the art. According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. As was held in *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that, which is disclosed therein. In this case, it is commonly known in that art that postage rates are based upon weight. Therefore, even though Bruns does not explicitly use postage rates as a threshold, it would have been prima facie obvious to one having ordinary skill in the art to use such rates since they are used for shipping products and are based upon the same thresholds such as weight taught in Bruns.

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11. As per claim 12, Goldberg in view of Bruns teaches the system of claim 10 as described above. Bruns further teaches the selected characteristic is chosen from the group comprising: item weight, item thickness and item size (§ 0006). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the selected characteristic is chosen from the group comprising: item weight, item thickness and item size into the system taught by Goldberg in view of Bruns because weight is a delivery parameter used for shipments (as taught by Bruns, § 0007).

12. As per claim 13, Goldberg in view of Bruns teaches the system of claim 10 as described above. Goldberg further teaches printing a mailer for each order (column 2, line 5; column 4, line 43); placing each mailer on an assembly line (column 4, lines 47-49); and placing each item in each order on the associated mailer as the mailer traverses the assembly line (column 4, line 68 - column 5, line 7; column 6, lines 49-51). Goldberg does not explicitly teach that the orders are sub-orders, however, Bruns teaches that the orders are sub-orders (§§ 0017) and it would have been prima facie obvious to include that the orders are sub-orders because the order has been split (as taught by Bruns, § 0009).

13. As per claim 14, Goldberg in view of Bruns teaches the system of claim 13 as described above. Goldberg further teaches each mailer comprises a printed paper

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mailer (column 2, line 68); each paper mailer includes, a bar code indicative of the items to be packaged with the mailer (column 3, line 55) and a customer address (column 3, lines 43-44; column 4, lines 67-68). Goldberg does not explicitly teach that these are on a first and a second side of the mailer. It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate that these are on a first and a second side of the mailer because this is a mere choice of arrangement and such differences from the prior art do not hold any patentable weight. *In re Japikse*, 86 USPQ 70 (CCPA 1950). Applicant has not demonstrated the criticalities of this arrangement.

14. As per claim 19, Goldberg teaches a method for selecting and packaging items for mailing, comprising the steps of: receiving a customer order specifying a plurality of items for shipping by mail (column 4, lines 15-16); retrieving a selected characteristic for each of the plurality of items (column 2, lines 26-27); printing a mailer including a control indicia on the mailer (column 5, line 65), automatically selecting, based on the control indicia, items for inclusion in each order (column 1, line 36 ("automated picking"); column 2, lines 25-29; column 4, lines 21-25), and packaging each of the orders individually so that the customer order comprises multiple packages (column 2, lines 43-44); and mailing the single or multiple packages to the customer (column 3, lines 18-19, 37). Goldberg does not teach determining, based on the selected characteristic, if a

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single delivery containing the plurality of items will exceed a desired threshold; if the single delivery will not exceed the desired threshold, packaging the items in a single delivery; if the single delivery will exceed the desired threshold, dividing, based on the selected characteristic, the customer order into multiple sub-orders, and each sub-order including a subset of the plurality of items selected so that the sub-order will be at the desired threshold. Bruns teaches determining, based on the selected characteristic, if a single delivery containing the plurality of items will exceed a desired threshold (§ 0008); if the single delivery will not exceed the desired threshold, packaging the items in a single delivery (§ 0014); if the single delivery will exceed the desired threshold, dividing, based on the selected characteristic, the customer order into multiple sub-orders, and each sub-order including a subset of the plurality of items selected so that the sub-order will be at the desired threshold (§ 0005). It would have been prima facie obvious to one having ordinary skill in the art to incorporate determining, based on the selected characteristic, if a single delivery containing the plurality of items will exceed a desired threshold; if the single delivery will not exceed the desired threshold, packaging the plurality of items in a single delivery; if the single delivery will exceed the desired threshold, dividing, based on the selected characteristic, the customer order into multiple sub-orders, and each sub-order including a subset of the plurality of items selected so that the sub-order will be at the desired threshold into the method taught by

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Goldberg so that the customer will receive products faster by eliminating delivery constraints (as taught by Bruns, ¶ 0009). Goldberg does not explicitly teach that the orders are sub-orders, however, Bruns teaches that the orders are sub-orders (¶¶ 0017) and it would have been prima facie obvious to include that the orders are sub-orders because the order has been split (as taught by Bruns, ¶ 0009). Bruns does not explicitly teach that the deliveries are packages, however, Goldberg teaches that the deliveries are packages (column 3, line 13; column 4, lines 33-38). Bruns teaches that the threshold is a weight or capacity threshold but does not explicitly teach that the threshold is a postal rate. However, the applied references have been interpreted and applied assuming basic knowledge of one of ordinary skill in the art. According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. As was held in *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that, which is disclosed therein. In this case, it is commonly known in that art that postage rates are based upon weight. Therefore, even though Bruns does not explicitly use postage rates as a threshold, it would have been prima facie obvious to one having ordinary skill in the art to use such rates since they are used for shipping products and are based upon the same thresholds such as weight taught in Bruns.

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15. As per claim 20, Goldberg teaches a system for selecting and packaging items for mailing, comprising: means for receiving a customer order specifying a plurality of items for shipping by mail (column 4, lines 15-16); means for retrieving a selected characteristic for each of the plurality of items (column 2, lines 26-27); printing a mailer including a control indicia on the mailer (column 5, line 65), automatically selecting, based on the control indicia, items for inclusion in each order (column 1, line 36 ("automated picking")); column 2, lines 25-29; column 4, lines 21-25), and packaging each of the orders individually so that the customer order comprises multiple packages (column 2, lines 43-44); and means for mailing the single or multiple packages to the customer (column 3, lines 18-19, 37). Goldberg does not teach means for determining, based on the selected characteristic, if a single delivery containing the plurality of items will exceed a desired threshold; means for if the single delivery will not exceed the desired threshold, packaging the items in a single delivery; means for if the single delivery will exceed the desired threshold, dividing, based on the selected characteristic, the customer order into multiple sub-orders, and each sub-order including a subset of the plurality of items selected so that the sub-order will be at the desired threshold. Bruns teaches means for determining, based on the selected characteristic, if a single delivery containing the plurality of items will exceed a desired threshold (§ 0008); means for if the single delivery will not exceed the desired threshold, packaging the items in a

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single delivery (§ 0014); means for if the single delivery will exceed the desired threshold, dividing, based on the selected characteristic, the customer order into multiple sub-orders, and each sub-order including a subset of the plurality of items selected so that the sub-order will be at the desired threshold (§ 0005). It would have been prima facie obvious to one having ordinary skill in the art to incorporate means for determining, based on the selected characteristic, if a single delivery containing the plurality of items will exceed a desired threshold; means for if the single delivery will not exceed the desired threshold, packaging the plurality of items in a single delivery; means for if the single delivery will exceed the desired threshold, dividing, based on the selected characteristic, the customer order into multiple sub-orders, and each sub-order including a subset of the plurality of items selected so that the sub-order will be at the desired threshold into the system taught by Goldberg so that the customer will receive products faster by eliminating delivery constraints (as taught by Bruns, § 0009).

Goldberg does not explicitly teach that the orders are sub-orders, however, Bruns teaches that the orders are sub-orders (§§ 0017) and it would have been prima facie obvious to include that the orders are sub-orders because the order has been split (as taught by Bruns, § 0009). Bruns does not explicitly teach that the deliveries are packages, however, Goldberg teaches that the deliveries are packages (column 3, line 13; column 4, lines 33-38). Bruns teaches that the threshold is a weight or capacity

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threshold but does not explicitly teach that the threshold is a postal rate. However, the applied references have been interpreted and applied assuming basic knowledge of one of ordinary skill in the art. According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. As was held in *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that, which is disclosed therein. In this case, it is commonly known in that art that postage rates are based upon weight. Therefore, even though Bruns does not explicitly use postage rates as a threshold, it would have been prima facie obvious to one having ordinary skill in the art to use such rates since they are used for shipping products and are based upon the same thresholds such as weight taught in Bruns.

16. As per claim 21, Goldberg teaches a method operable on a computer for selecting and packaging items for mailing, comprising the steps of: receiving a customer order specifying a plurality of items for shipping by mail (column 4, lines 15-16); packaging each of the orders individually so that the customer order comprises multiple packages (column 2, lines 43-44); and mailing the single or multiple packages to the customer (column 3, lines 18-19, 37). Goldberg does not teach determining, based on a selected characteristic for each of the plurality of items, if a single delivery containing the plurality of items will exceed a desired threshold; if the single delivery will not

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exceed the desired threshold, packaging the plurality of items in a single delivery; if the single delivery will exceed the desired threshold, dividing, based on the selected characteristic, the customer order into multiple sub-orders, and each sub-order including a subset of the plurality of items selected so that the sub-order will be at the desired threshold. Bruns teaches determining, based on a selected characteristic for each of the plurality of items, if a single delivery containing the plurality of items will exceed a desired threshold (§ 0008); if the single delivery will not exceed the desired threshold, packaging the plurality of items in a single delivery (§ 0014); if the single delivery will exceed the desired threshold, dividing, based on the selected characteristic, the customer order into multiple sub-orders, and each sub-order including a subset of the plurality of items selected so that the sub-order will be at the desired threshold (§ 0005). It would have been prima facie obvious to one having ordinary skill in the art to incorporate determining, based on a selected characteristic for each of the plurality of items, if a single delivery containing the plurality of items will exceed a desired threshold; if the single delivery will not exceed the desired threshold, packaging the plurality of items in a single delivery; if the single delivery will exceed the desired threshold, dividing, based on the selected characteristic, the customer order into multiple sub-orders, and each sub-order including a subset of the plurality of items selected so that the sub-order will be at the desired threshold into the method taught by

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Goldberg so that the customer will receive products faster by eliminating delivery constraints (as taught by Bruns, ¶ 0009). Goldberg does not explicitly teach that the orders are sub-orders, however, Bruns teaches that the orders are sub-orders (¶¶ 0017) and it would have been prima facie obvious to include that the orders are sub-orders because the order has been split (as taught by Bruns, ¶ 0009). Bruns does not explicitly teach that the deliveries are packages, however, Goldberg teaches that the deliveries are packages (column 3, line 13; column 4, lines 33-38). Bruns teaches that the threshold is a weight or capacity threshold but does not explicitly teach that the threshold is a postal rate. However, the applied references have been interpreted and applied assuming basic knowledge of one of ordinary skill in the art. According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. As was held in *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that, which is disclosed therein. In this case, it is commonly known in that art that postage rates are based upon weight. Therefore, even though Bruns does not explicitly use postage rates as a threshold, it would have been prima facie obvious to one having ordinary skill in the art to use such rates since they are used for shipping products and are based upon the same thresholds such as weight taught in Bruns.

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17. As per claim 22, Goldberg teaches a method operable on a computer for selecting and packaging items for mailing, comprising the steps of: receiving a customer order specifying a plurality of items for shipping by mail (column 4, lines 15-16); printing a single mailer including a control indicia for operating a machine to place the plurality of items into a single package (column 5, line 65; column 6, lines 48-51); printing a plurality of mailers, each of the plurality of mailers including a control indicia for operating a machine to place a selected subset of the plurality of items into a package, the multiple packages associated with the plurality of mailers together fulfilling the customer order (column 2, lines 43-44; column 5, line 65; column 6, lines 48-51).

Goldberg does not teach determining, based on a selected characteristic of each of the plurality of items, if a single delivery containing the plurality of items will exceed a desired threshold; that the printing of a single mailer occurs if the single delivery will not exceed the desired threshold; and that the printing of a plurality of mailers occurs if the single delivery will exceed the desired threshold. Bruns teaches determining, based on a selected characteristic for each of the plurality of items, if a single delivery containing the plurality of items will exceed a desired threshold (§ 0008). It would have been prima facie obvious to one having ordinary skill in the art to incorporate determining, based on a selected characteristic for each of the plurality of items, if a single delivery containing the plurality of items will exceed a desired threshold into the method taught by Goldberg

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so that the customer will receive products faster by eliminating delivery constraints (as taught by Bruns, ¶ 0009). Bruns does not explicitly teach that the printing of a single mailer occurs if the single package will not exceed the desired threshold; and that the printing of a plurality of mailers occurs if the single package will exceed the desired threshold. It would have been prima facie obvious to incorporate that the printing of a single mailer occurs if the single package will not exceed the desired threshold; and that the printing of a plurality of mailers occurs if the single package will exceed the desired threshold after the determination step taught by Bruns into the method taught by Goldberg in view of Bruns because of the teachings of order dividing in Bruns and because packages require mailers (as taught by Goldberg, column 1, line 45). Bruns does not explicitly teach that the deliveries are packages, however, Goldberg teaches that the deliveries are packages (column 3, line 13; column 4, lines 33-38). Bruns teaches that the threshold is a weight or capacity threshold but does not explicitly teach that the threshold is a postal rate. However, the applied references have been interpreted and applied assuming basic knowledge of one of ordinary skill in the art. According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. As was held in *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that,

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which is disclosed therein. In this case, it is commonly known in that art that postage rates are based upon weight. Therefore, even though Bruns does not explicitly use postage rates as a threshold, it would have been prima facie obvious to one having ordinary skill in the art to use such rates since they are used for shipping products and are based upon the same thresholds such as weight taught in Bruns.

18. Claims 2, 9, 11, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg in view of Bruns as applied to claims 1 and 10 above, in further view of Official Notice.

19. As per claim 2, Goldberg in view of Bruns teaches the method of claim 1 as described above. Goldberg in view of Bruns does not explicitly teach the customer order is received by mail on a pre-printed form. Official Notice is taken that it would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the customer order is received by mail on a pre-printed form into the method taught by Goldberg in view of Bruns because it is common in the art of fulfilling customer orders to receive such orders from customers on forms that are pre-printed by the company in order to make order processing standardized and therefore simpler.

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20. As per claim 9, Goldberg in view of Bruns teaches the method of claim 1 as described above. Goldberg in view of Bruns does not explicitly teach that receiving a customer order is performed at a location geographically remote from the step of packaging each of the sub-orders. Official Notice is taken that it would have been prima facie obvious to one having ordinary skill in the art to incorporate that receiving a customer order is performed at a location geographically remote from the step of packaging each of the sub-orders into the method taught by Goldberg in view of Bruns because it is common to have separate locations for order receipt and processing and fulfillment in order to promote efficiency by having a central processing facility.

21. As per claim 11, Goldberg in view of Bruns teaches the system of claim 10 as described above. Goldberg in view of Bruns does not explicitly teach the customer order is received by mail on a pre-printed form. Official Notice is taken that it would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the customer order is received by mail on a pre-printed form into the method taught by Goldberg in view of Bruns because it is common in the art of fulfilling customer orders to receive such orders from customers on forms that are pre-printed by the company in order to make order processing standardized and therefore simpler.

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22. As per claim 18, Goldberg in view of Bruns teaches the system of claim 10 as described above. Goldberg in view of Bruns does not explicitly teach that receiving a customer order is performed at a location geographically remote from the step of packaging each of the sub-orders. Official Notice is taken that it would have been prima facie obvious to one having ordinary skill in the art to incorporate that receiving a customer order is performed at a location geographically remote from the step of packaging each of the sub-orders into the system taught by Goldberg in view of Bruns because it is common to have separate locations for order receipt and processing and fulfillment in order to promote efficiency by having a central processing facility.

23. Claims 6-7 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg in view of Bruns as applied to claims 5 and 14 above, in further view of Farmer, U.S. Pat. No. 2,276,293 (Reference C of the attached PTO-892).

24. As per claim 6, Goldberg in view of Bruns teaches the method of claim 5 as described above. Goldberg further teaches a scanner for reading the bar code on each mailer (column 5, line 53) and that order fulfilling is done by mechanized apparatus (column 4, lines 23-25). Goldberg in view of Bruns does not explicitly teach a plurality of hoppers, each hopper containing a plurality of like items; and a mechanism responsive to computer control for moving an item from a hopper onto a mailer. Farmer

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teaches a plurality of hoppers (page 2, left column, line 8), each hopper containing a plurality of like items (page 2, left column, line 9); and a mechanism for moving an item from a hopper onto a mailer (page 4, right column, line 71 - page 5, left column, line 2).

It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate a plurality of hoppers, each hopper containing a plurality of like items; and a mechanism for moving an item from a hopper onto a mailer into the method taught by Goldberg in view of Bruns in order to reduce cost, minimize time involved, and insure greater accuracy in assembling orders (as taught by Farmer, page 1, left column, lines 39-41). Farmer teaches that the mechanism is electronically actuated using a circuit (page 3, left column, lines 9-10) but does not explicitly teach that the mechanism is responsive to computer control. However, Goldberg teaches that the mechanism is responsive to computer control (column 6, lines 48-50).

25. As per claim 7, Goldberg in view of Bruns and Farmer teaches the method of claim 6 as described above. Goldberg in view of Bruns and Farmer does not teach including a customer message on the front of a mailer readable by a customer and indicating that a customer order has been fulfilled in multiple packages. It would have been prima facie obvious to incorporate including a customer message on the front of a mailer readable by a customer and indicating that a customer order has been fulfilled in multiple packages because these are merely words and this limitation is a non-

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functional descriptive material, and as such is afforded no patentable weight because non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *In re Gulack*, 217 USPQ 401, 404 (Fed. Cir. 1983).

26. As per claim 15, Goldberg in view of Bruns teaches the system of claim 14 as described above. Goldberg further teaches a scanner for reading the bar code on each mailer (column 5, line 53) and that order fulfilling is done by mechanized apparatus (column 4, lines 23-25). Goldberg in view of Bruns does not explicitly teach a plurality of hoppers, each hopper containing a plurality of like items; and a mechanism responsive to computer control for moving an item from a hopper onto a mailer. Farmer teaches a plurality of hoppers (page 2, left column, line 8), each hopper containing a plurality of like items (page 2, left column, line 9); and a mechanism for moving an item from a hopper onto a mailer (page 4, right column, line 71 - page 5, left column, line 2). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate a plurality of hoppers, each hopper containing a plurality of like items; and a mechanism for moving an item from a hopper onto a mailer into the system taught by Goldberg in view of Bruns in order to reduce cost, minimize time involved, and insure greater accuracy in assembling orders (as taught by Farmer, page 1, left column, lines 39-41). Farmer teaches that the mechanism is electronically actuated using a circuit (page 3, left column, lines 9-10) but does not explicitly teach

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that the mechanism is responsive to computer control. However, Goldberg teaches that the mechanism is responsive to computer control (column 6, lines 48-50).

27. As per claim 16, Goldberg in view of Bruns and Farmer teaches the system of claim 15 as described above. Goldberg in view of Bruns and Farmer does not teach including a customer message on the front of a mailer readable by a customer and indicating that a customer order has been fulfilled in multiple packages. It would have been prima facie obvious to incorporate including a customer message on the front of a mailer readable by a customer and indicating that a customer order has been fulfilled in multiple packages because these are merely words and this limitation is a non-functional descriptive material, and as such is afforded no patentable weight because non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *In re Gulack*, 217 USPQ 401, 404 (Fed. Cir. 1983).

28. Claims 8 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg in view of Bruns and Farmer as applied to claims 7 and 16 above, in further view of Official Notice.

29. As per claim 8, Goldberg in view of Bruns and Farmer teaches the method of claim 7 as described above. Goldberg in view of Bruns and Farmer does not teach that packaging each of the sub-orders includes shrink-wrapping each of the sub-orders in a

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plastic wrap so that the customer address and customer message are readable through the plastic wrap. Official Notice is taken that it would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate packaging each of the sub-orders includes shrink-wrapping each of the sub-orders in a plastic wrap so that the customer address and customer message are readable through the plastic wrap into the method taught by Goldberg in view of Bruns and Farmer because plastic wrap is commonly used in such a manner when shipping packages to provide stability and protection.

30. As per claim 17, Goldberg in view of Bruns and Farmer teaches the system of claim 16 as described above. Goldberg in view of Bruns and Farmer does not teach that packaging each of the sub-orders includes shrink-wrapping each of the sub-orders in a plastic wrap so that the customer address and customer message are readable through the plastic wrap. Official Notice is taken that it would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate packaging each of the sub-orders includes shrink-wrapping each of the sub-orders in a plastic wrap so that the customer address and customer message are readable through the plastic wrap into the system taught by Goldberg in view of Bruns and Farmer because plastic wrap is commonly used in such a manner when shipping packages to provide stability and protection.

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Conclusion


31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Anderson, et al., U.S. Pat. Pub. No. 2002/0173983 (Reference D of the attached PTO-892) teaches a system and method of processing an order comprising receiving an order for desired items, and calculating a collective physical parameter(s) of the items such as a total weight of the items, a total volume of the items and/or a total number of cases of the items; wherein the calculated collective physical parameter(s) is compared with a predetermined threshold(s) reflecting a physical capacity or capability of one standard full carrier. Altendahl, et al., U.S. Pat. No. 6,957,197 (Reference E of the attached PTO-892) teaches a system for managing shipping parcels that includes a specially adapted set of load planning tables, or, from another aspect, a set of load planning tables for use with a system for managing shipping parcels.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel P. Vetter whose telephone number is (571) 270-1366. The examiner can normally be reached on Monday through Thursday from 8am to 5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Nolan can be reached on (571) 272-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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